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09/621,234	07/20/2000	Wayne Jerald Henshaw	ZEN-9501-A-RE	3325
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BERESKIN AND PARR 40 KING STREET WEST BOX 401 TORONTO, ON M5H 3Y2 CANADA			EXAMINER FORTUNA, ANA M	
			ART UNIT 1723	PAPER NUMBER

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/621,234

Filing Date: July 20, 2000  
Appellant(s): HENSHAW ET AL.

**MAILED**

DEC 01 2006

**GROUP 1700**

Scott Pundsack

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For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 4/3/06 appealing from the Office action mailed 6/30/05.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief. See supplemental letter filed on 6/30/06.

**(2) Related Appeals and Interferences**

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

11/049,988, and 11/059,403, an appeal brief has not been filed yet.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

Application 08/690,045 record.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 15-18 and 23 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Claims 1 and 9 in application 08/690,045, now US 5,783,083, both have the following proviso:

**the improvement comprising:**

**each said header having said fibers spaced apart by a flexible support means having a thickness corresponding to a desired lateral spacing between adjacent fibers, said support means extending over only each terminal portion of said fibers near their ends, so as to maintain said ends in closely-paced apart relationship.**

The proviso was added by amendment on January 12, 1998, along with extensive arguments of how the newly added limitation distinguishes the claimed invention over the prior art cited by the Examiner. At p. 7 of that amendment, for instance, the applicant's refer to the "flexible support means having a thickness corresponding to a desired lateral spacing between adjacent fibers" as the "second essential element" which gave their invention a clear advantage over the prior art.

The record is clear, therefore, that the applicants surrendered broader coverage when they added the proviso to the claims in order to obtain a patent. Claims 15-18 and 23 in this reissue lack that limitation and thus they are rejected under 35 USC 251 as involving an improper attempt to recapture surrendered subject matter. See MPEP 1412.02.

It is noted that claim 15 in this reissue includes limitations narrowing the scope of the claims as follow: a pump; and

at least a portion of the membranes spaced apart from adjacent membranes by the potting material to a center-to-center distance in the range from 1.2 to 5 times the outside diameter of the membrane,

these limitations were not recited in claims 1 and 9 of 08/690,045, now US 5,783,083. Nevertheless, claims 15-18 and 23 in this reissue are missing the aforementioned proviso, which was "an aspect to germane to a prior art rejection". Therefore, the claims are "broader in scope in some aspects and narrower in others".

#### **(10) Response to Argument**

Applicant refers to the three steps test for recapture (see MPEP 1412.02), and acknowledges that claims 15-18 and 23 are **broader in some aspects** than the limitations of claims 1 and 9 of US patent 5,783,083, although is narrower in other aspects.

The Examiner disagree with applicant statement of "it is also the same as", because although the added limitations states that the membranes are "spaced-apart from adjacent membranes by a potting material", and add the distance range; the potting material does not replace the "flexible support means having thickness corresponding to a desired lateral spacing between adjacent fibers ..."

The flexible support means are defined in the specification as "flexible planar support means such as strips or cards which can be formed into a loose roll, glue to the fiber ends" (see patent 5,784,083, column 12, last paragraph bridging column 13, lines 1-16). Regarding to the second test or step, the broader aspect, e.g. fiber spacing range, was not part of the claims in application 08/690,045.

Regarding to the third test for determining recapture,

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(a) Reissue Claims are Narrower in Scope Than Patent Claims, in Area Not Directed to Amendment/Argument Made to Overcome Art Rejection in Original Prosecution; are Broader in Scope by Omitting Limitation(s) Added/Argued To Overcome Art Rejection in Original Prosecution.

In this case there is Recapture.

The omitted limitation is the "flexible support means", which according to the patent specification are potted within the potting ring forming the header (or solid body).

Applicant argues that claim 15 contains "a broadened form of the limitation added to secure allowance of patent 5,783,083". The broadened form lacks the essential element "flexible support means" securing the spacing between the fibers within the potting material to avoid fiber damage, which advantage of the prior art is argued in amendment to 08/690,045, filed on 1/12/1998. The fibers of the prior art are spaced forming a bundle with ends potted in a header, as discussed in paper of 9/18/1997.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

  
Ana M. Fortuna

Primary Examiner

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